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| CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002 | | | EXAMINER SMITH, RUTH S | |
| | | | ART UNIT 3737 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,381

Applicant(s)

HOPPEL ET AL.

Examiner

Ruth S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Drawings

The drawings are objected to under 37 CFR 1.84(h)(5) because Figure 1 show(s) modified forms of construction in the same view. Paragraph 0023 sets forth that an alternate embodiment is shown in figure 1, however, the figure fails to show the alternate embodiment in phantom. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: In paragraph 0023, line 16, "dimension a" should be "dimension at". Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon

definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “underlapping” in claims 1-26 is used by the claim to mean “spaced from”, while the accepted meaning is “to extend partly under.” The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6,13,20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Lampman et al (6,889,073). The claims are directly readable on Lampman et al which discloses first, second, third and fourth coils, as seen in figures 1,2. The first and second coils each have an opening through which the breast is positioned when the patient lies in a prone position. The third and fourth coils are opposed to the first and second coils. The first and second coils are spaced from one another and therefore are considered to be “underlapping”. The third and fourth coils are spaced from one another and therefore are considered to be “underlapping”.

Claims 1-6,20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lian et al (5,804,969). The claims are directly readable on Lian et al which discloses first, second, third and fourth coils, as seen in figures 1,4,5. The first and second coils each have an opening through which the breast is positioned when the patient lies in a

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prone position. The third and fourth coils are opposed to the first and second coils. The first and second coils are spaced from one another and therefore are considered to be "underlapping". The third and fourth coils are spaced from one another and therefore are considered to be "underlapping".

Claims 1-4,6,12,21 are rejected under 35 U.S.C. 102(b) as being anticipated by Su (6,163,717). The claims are directly readable on Su which discloses first, second, third and fourth coils, as seen in figures 1,4. The first and second coils each have an opening through which the breast is positioned when the patient lies in a prone position. The third and fourth coils are opposed to the first and second coils. The first and second coils are spaced from one another and therefore are considered to be "underlapping". The third and fourth coils are spaced from one another and therefore are considered to be "underlapping". The first pair of coils have windings that are non-planar.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampman et al or Su or Lian et al. Lampman et al, Su and Lian et al each disclose first, second, third and fourth coils. The first and second coils each have an opening through which the breast is positioned when the patient lies in a prone position. The third and fourth coils are opposed to the first and second coils. The first and second coils are spaced from one another and therefore are considered to be "underlapping". The third and fourth coils are spaced from one another and therefore are considered to be "underlapping". Lampman et al, Su and Lian et al each fail to disclose the specific dimensions of the coils. The dimensions selected would have been obvious to one skilled in the art without undue experimentation based upon known sizes of a patient's breast.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampman et al. Lampman et al discloses first, second, third and fourth coils, as seen in figures 1,2. The first and second coils each have an opening through which the breast is positioned when the patient lies in a prone position. The third and fourth coils are opposed to the first and second coils. The first and second coils are spaced from one another and therefore are considered to be "underlapping". The third and fourth coils are spaced from one another and therefore are considered to be "underlapping". Lampman et al fails to disclose that the distance between the coils is adjustable. It is a well known expedient in the art to provide means for adjusting distance between components fitted to a patient so as to accommodate all different patient sizes. It would have been obvious to one skilled in the art to have modified Lampman et al such that the distance between coils is adjustable in order to accommodate different sized patients.

Allowable Subject Matter

Claims 15-19,23,24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 25,26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

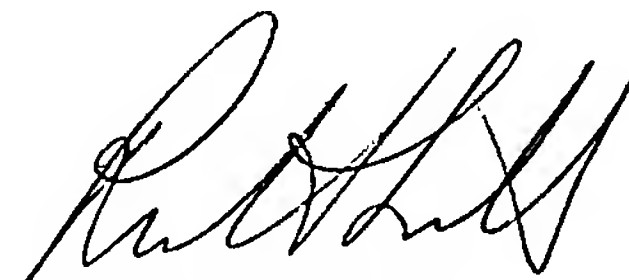
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eydelman discloses an MRI arrangement for imaging of the breast.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ruth S. Smith
Primary Examiner
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